

# Exhibit 1

FCMCCG.002DV1

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	John McDonald et al.	)	CERTIFICATE OF EFS WEB
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Appl. No.	:	10/726,256	)	I hereby certify that this correspondence,
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			)	<u>December 23, 2008</u>
			)	(Date)
Examiner	:	Jacob K. Ackun	)	<u>/Michael Guillana/</u>
			)	Michael A. Guillana, Reg. No. 42,611
Group Art Unit:	:	3728	)	

### AMENDMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action notified July 23, 2008, Applicants respectfully submit the following papers in connection with the above-captioned application.

**Amendments to the Claims** are reflected in the listing of claims which begins on page 2 of this paper.

**Remarks/Arguments** begin on page 9 of this paper.

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IN THE CLAIMS:

**Please amend Claims 33, 36, 38, 45 and 74 as follows:**

1 - 32. (Canceled)

33. (Currently Amended) A packaging assembly comprising:

a first open-sided frame member having first and second free edges,

a second open-sided frame member having third and fourth free edges,

a first retention member extending between the first and second free edges and comprising a sheet material,

a second retention member extending between the third and fourth free edges and comprising a sheet material,

~~wherein the first frame member and the first retention member are engaged with each other to form a first subassembly, wherein the second frame member and the second retention member are engaged with each other to form a second subassembly, wherein the first and second frame members being are configured to nest with each other,~~

wherein the first frame member comprises first and second wall structures supporting the first and second free edges, respectively, so as to define and defining first and second open sides between the first and second wall structures,

wherein the second frame member comprises third and fourth wall structures supporting the third and fourth free edges, respectively, so as to define and defining third and fourth open sides between the third and fourth wall structures,

wherein the first and second free edges are configured to be positioned in the third and fourth open sides in nesting engagement, respectively, and wherein the third and fourth free edges are configured to be positioned in the first and second open sides in nesting engagement, respectively,

wherein the first wall structure comprises two side edges generally perpendicular to the first free edge, wherein the second wall structure comprises two side edges generally perpendicular to the second free edge, wherein the third wall structure comprises two side edges generally perpendicular to the third free edge,

wherein the first and second frames are sized such that a distance between

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the side edges of the third wall structure is substantially same with that between one of the side edges of the first wall structure and one of the side edges of the second wall structure when viewed in a direction perpendicular to the third wall structure in nesting engagement.

34. (Original) The assembly according to Claim 33, wherein the first and second retention members are substantially resilient, the first and second frame members being substantially rigid.

35. (Original) The assembly according to Claim 33, wherein the first frame member includes at least a first tapered portion extending from the first free edge.

36. (Currently Amended) A packaging assembly comprising  
a first open-sided frame member having first and second free edges,  
a second open-sided frame member having third and fourth free edges,  
a first retention member extending between the first and second free edges and comprising a sheet material,  
a second retention member extending between the third and fourth free edges and comprising a sheet material,  
~~wherein the first frame member and the first retention member are engaged with each other to form a first subassembly, wherein the second frame member and the second retention member are engaged with each other to form a second subassembly, wherein~~ the first and second frame members are being configured to nest with each other,

wherein the first frame member comprises first and second wall structures supporting the first and second free edges, respectively, ~~so as to define and defining~~ first and second open sides between the first and second wall structures,

wherein the second frame member comprises third and fourth wall structures supporting the third and fourth free edges, respectively, ~~so as to define and defining~~ third and fourth open sides between the third and fourth wall structures,

wherein the first and second free edges are configured to be positioned in the third and fourth open sides in nesting engagement, respectively, wherein the third and fourth free edges are configured to be positioned in the first and second open sides in nesting engagement, respectively,

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wherein the first wall structure comprises two side edges substantially perpendicular to the first free edge, wherein the first frame member includes at least a first tapered portion extending from the first free edge toward the first side edge, wherein the first tapered portion interconnects and is interposed between the first free edge and the first side edge, and wherein the third wall structure includes at least a first inclined wall extending from the third free edge, the first tapered portion being configured to receive the first inclined wall in nesting engagement.

37. (Original) The assembly according to Claim 33, wherein the first and second free edges extend longitudinally, each of the first and second free edges including tapered portions disposed at opposite longitudinal ends thereof.

38. (Currently Amended) A packaging assembly comprising:

a first open-sided frame member having first and second free edges, a second open-sided frame member having third and fourth free edges,

a first retention member extending between the first and second free edges and comprising a sheet material,

a second retention member extending between the third and fourth free edges and comprising a sheet material,

~~wherein the first frame member and the first retention member are engaged with each other to form a first subassembly, wherein the second frame member and the second retention member are engaged with each other to form a second subassembly, wherein the first and second frame members are being configured to nest with each other,~~

wherein the first frame member comprises first and second wall structures supporting the first and second free edges, respectively, and defining so as to define first and second open sides between the first and second wall structures,

wherein the second frame member comprises third and fourth wall structures supporting the third and fourth free edges, respectively, and defining so as to define third and fourth open sides between the third and fourth wall structures,

wherein the first and second free edges are configured to be positioned in the third and fourth open sides in nesting engagement, respectively, wherein the third and fourth free edges are configured to be positioned in the first and second open

sides in nesting engagement, respectively,

wherein the first and second free edges extend longitudinally, each of the first and second free edges including tapered portions disposed at opposite longitudinal ends thereof, wherein the first wall structure comprises first and second side edges substantially perpendicular to the first free edge, wherein a first one of the tapered portions extends toward the first side edge and is interposed between the first free edge and the first side edge, and

wherein the third and fourth wall structures comprises third and fourth inclined walls supporting the third and fourth free edges, respectively, the tapered portions being configured to receive the inclined walls in nesting engagement.

39. (Original) The assembly according to Claim 38, wherein at least one of the tapered portions and the inclined walls are configured such that the first and second retention members are deflected inwardly when the tapered portions and the inclined walls are nested.

40. (Original) The assembly according to Claim 39 additionally comprising a first recessed area of the first frame member disposed between the first and second free edges and a second recessed area of the second frame member disposed between the third and fourth free edges.

41. (Original) The assembly according to Claim 40, wherein the first and second retention members are deflected toward the first and second recessed areas, respectively, when the tapered portions and the inclined walls are nested.

42. (Canceled)

43. (Previously Presented) The assembly according to Claim 33, wherein the first and second wall structures comprises first and second peripherally extending structures supporting the first and second free edges, respectively, the third and fourth wall structures comprising third and fourth peripherally extending structures supporting the third and fourth free edges, respectively.

44. (Original) The assembly according to Claim 43, additionally comprising tapered portions formed on the opposite ends of each of the first and second free edges, and at least first and second inclined walls forming a portion of the third and fourth peripherally extending structures, respectively.

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45. (Currently Amended) A packaging assembly comprising:
- a first open-sided frame member having first and second free edges,
  - a second open-sided frame member having third and fourth free edges,
  - a first retention member extending between the first and second free edges and comprising a sheet material,
  - a second retention member extending between the third and fourth free edges and comprising a sheet material,
  - ~~wherein the first frame member and the first retention member are engaged with each other to form a first subassembly, wherein the second frame member and the second retention member are engaged with each other to form a second subassembly, wherein~~ the first and second frame members are being configured to nest with each other,
  - wherein the first frame member comprises first and second wall structures supporting the first and second free edges, respectively, ~~and defining so as to define~~ first and second open sides between the first and second wall structures,
  - wherein the second frame member comprises third and fourth wall structures supporting the third and fourth free edges, respectively, ~~and defining so as to define~~ third and fourth open sides between the third and fourth wall structures,
  - wherein the first and second free edges are configured to be positioned in the third and fourth open sides in nesting engagement, respectively,
  - wherein the third and fourth free edges are configured to be positioned in the first and second open sides in nesting engagement, respectively, wherein each of the first and second peripheral extending structures comprises two walls, wherein one of the walls inclined with respect to the other of the walls,
  - wherein the first and second wall structures comprise first and second peripherally extending structures supporting the first and second free edges, respectively,
  - wherein the third and fourth wall structures ~~comprise comprising~~ third and fourth peripherally extending structures supporting the third and fourth free edges, respectively, and
  - wherein the assembly additionally comprises tapered portions formed on the

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opposite ends of each of the first and second free edges, and at least first and second inclined walls forming a portion of the third and fourth peripherally extending structures, respectively, and wherein the tapered portions extend along a first angle of inclination, the first and second inclined walls extending along a second angle of inclination that is approximately equal to the first angle of inclination.

46. (Original) The assembly according to Claim 44, wherein the first, second, third, and fourth peripherally extending structures are triangular in cross section.

47 - 73. (Canceled)

74. (Currently Amended) A packaging assembly comprising a first frame member having first and second free edges, a second frame member having third and fourth free edges, a first retention sleeve surrounding the first frame member and comprising a first retention portion which extends between the first and second free edges, a second retention sleeve surrounding the second frame member and comprising a second retention portion which extends between the third and fourth free edges, the first and second frame members being configured to be assembled such that an article is located between the first retention portion and the second retention portion nest with each other.

75. (Previously Presented) The assembly according to Claim 74, wherein the first and second retention portions are substantially resilient, the first and second frame members being substantially rigid.

76. (Previously Presented) The assembly according to Claim 74, wherein the first frame member includes at least a first tapered portion extending from the first free edge.

77. (Previously Presented) The assembly according to Claim 74, wherein the first frame member includes at least a first tapered portion extending from the first free edge, and wherein the second frame member includes at least a first inclined wall extending from the third free edge, the first tapered portion being configured to receive the first inclined wall in nesting engagement.

78. (Previously Presented) The assembly according to Claim 74, wherein the first and second free edges extend longitudinally, each of the first and second free edges including tapered portions disposed at opposite longitudinal ends thereof.

79. (Previously Presented) The assembly according to Claim 74, wherein the first and second free edges extend longitudinally, each of the first and second free edges

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including tapered portions disposed at opposite longitudinal ends thereof, and wherein the assembly additionally comprises third and fourth inclined walls supporting the third and fourth free edges, respectively, the tapered portions being configured to receive the inclined walls in nesting engagement.

80. (Previously Presented) The assembly according to Claim 79, wherein at least one of the tapered portions and the inclined walls are configured such that the first and second retention portions are deflected inwardly when the tapered portions and the inclined walls are nested.

81. (Previously Presented) The assembly according to Claim 80, additionally comprising a first recessed area of the first frame member disposed between the first and second free edges and a second recessed area of the second frame member disposed between the third and fourth free edges.

82. (Previously Presented) The assembly according to Claim 81, wherein the first and second retention portions are deflected toward the first and second recessed areas, respectively, when the tapered portions and the inclined walls are nested.

83. (Previously Presented) The assembly according to Claim 74, wherein the first frame member comprises first and second peripherally extending structures supporting the first and second free edges, respectively, the second frame member comprising third and fourth peripherally extending structures supporting the third and fourth free edges, respectively.

84. (Previously Presented) The assembly according to Claim 83, additionally comprising tapered portions formed on the opposite ends of each of the first and second free edges, and at least first and second inclined walls forming a portion of the third and fourth peripherally extending structures, respectively.

85. (Previously Presented) The assembly according to Claim 84, wherein the tapered portions extend along a first angle of inclination, the first and second inclined walls extending along a second angle of inclination that is approximately equal to the first angle of inclination.

86. (Previously Presented) The assembly according to Claim 84, wherein the first, second, third, and fourth peripherally extending structures are triangular in cross section.



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#### COMMENTS

Claims 33-41, 43-46 and 74-86 remain pending in the present application, Claims 33, 36, 38, 45 and 74 having been amended. The claims set forth above include marking to show the changes made by way of the present amendment, deletions being in ~~strikeout~~ and additions being underlined.

In response to the Office Action notified July 23, 2008, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

#### Amendments to the Claims Add No New Matter

Applicants have amended Claims 33, 36, 38, 45 and 74. Support for the amendments to Claim 33 can be found in, for example, Figure 8 of the application originally filed. Support for the amendments to Claims 36 and 38 can be found in, for example, Figures 4 and 8 and related descriptions of the application originally filed. Support for the amendments to Claim 45 can be found in, for example, Figures 3, 6 and 8 and related descriptions of the application originally filed. Support for amendments to Claim 74 can be found in, for example, Figure 8 and related descriptions of the application originally filed. As such, the amendments to the claims add no new matter.

#### Ridgeway does not Make Claims 33-41, 43-46 and 74-86 Anticipated or Obvious

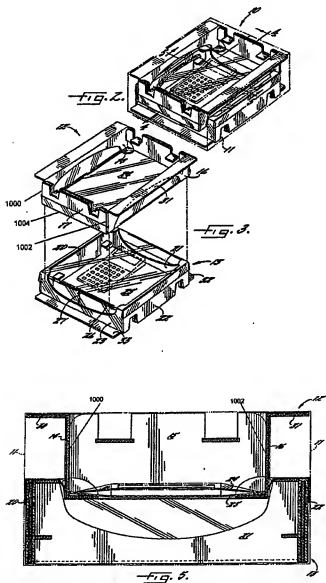
Claims 33-41, 43-46 and 74-86 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over US Patent No. 5,388,701 to Ridgeway. Applicants respectfully traverse the present rejection. However, in order to expedite prosecution of the present application, Applicants have amended the claims as set forth above. Applicants expressly reserve the right to further prosecute the original versions of the claims through continuation practice.

#### Ridgeway

Ridgeway teaches a suspension package having two suspension frames 12 and 13. The frames 12 and 13 have flexible plastic films 24 and 25, respectively. The frame 12 has four side panels 14, 15, 16 and 17. Each of two opposite side panels 14 and 16 has an arch. The frame 13 has four side panels 20, 21, 22 and 23. Each of two opposite side panels 21 and 23 has an

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arch. When the frames 12 and 13 are contained in a box, the arched side panels 14 and 16 of the frame 12 are positioned perpendicularly to the arched side panels 21 and 23 of the frame 13. For the Examiner's convenience, Figures 2, 3 and 5 are reproduced below, in which reference numbers are further added.



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The frames 12 and 13 of Ridgeway, however, are sized such that a distance between the side panels 20 and 22 is much greater than a length of side panel 15 when assembled. Thus, the side panels 20 and 22 located beyond side edges 1000 and 1002 of the side panel 15. See Figure 5 below.

Further, in the frame 12 and 13 of Ridgeway, open sides are provided between the side panels 15 and 17 and between the side panels 20 and 22. However, any one of the side panels 15, 17, 20 and 22 has no tapered portion between the free edge, for example, 1004 and the side edges, for example 1000 and 1004.

In the frame 12 and 13, each of the side panels 15, 17, 20 and 22 appears to have two or more walls. However, any one of the side panels has no wall inclined with respect to the other walls of each of the side panels.

Claim 33

In contrast with Ridgeway, Claim 33 now recites, among other recitation, "wherein the first wall structure comprises two side edges generally perpendicular to the first free edge, wherein the second wall structure comprises two side edges generally perpendicular to the second free edge, wherein the third wall structure comprises two side edges generally perpendicular to the third free edge, wherein the first and second frames are sized such that a distance between the side edges of the third wall structure is substantially same with that between one of the side edges of the first wall structure and one of the side edges of the second wall structure when viewed in a direction perpendicular to the third wall structure in nesting engagement."

Applicants also respectfully direct the Examiner to Figure 8. In the non-limiting embodiment of Figure 8 in the present Application, a distance between side edges 500 and 502 of the peripherally extending structure 58' is substantially same with that between side edge 600 of the peripherally extending structure 58 and side edge 700 of the peripherally extending structure 60. For the Examiner's convenience, Figure 8 is reproduced below with additional reference numbers.

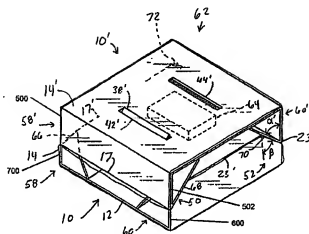


FIG. 8

As discussed above, the frames 12 and 13 of Ridgeway, however, are sized such that a distance between the side panels 20 and 22 is much greater than a length of side panel 15 when assembled. See Figure 5 of Ridgeway.

As such, Ridgeway fails to teach or suggest such features among other features of Claim 33. Therefore, Ridgeway does not teach or suggest all the features of Claim 33, and its dependent Claims 34, 35, 37, 43, 44 and 46. There is no additional reference or non-reference prior art to remedy the deficiencies of Ridgeway. Further, there is no explanation as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Therefore, no *prima facie* case of anticipation or obviousness has been established. Applicants respectfully request the withdrawal of the rejection to Claim 33 and its dependent Claims 34, 35, 37, 43, 44 and 46.

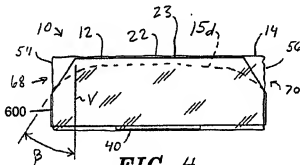
#### Claims 36 and 38

In contrast with Ridgeway, Claim 36 recites, among other recitation, "wherein the first frame member comprises first and second wall structures supporting the first and second free edges, respectively, and defining first and second open sides between the first and second wall structures," and "wherein the first wall structure comprises two side edges substantially perpendicular to the first free edge, wherein the first frame member includes at least a first tapered portion extending from the first free edge toward the first side edge, wherein the first tapered portion interconnects and is interposed between the first free edge

and the first side edge."

Claim 38 recites, among other recitation, “wherein the first frame member comprises first and second wall structures supporting the first and second free edges, respectively, and defining first and second open sides between the first and second wall structures,” and “wherein the first and second free edges extend longitudinally, each of the first and second free edges including tapered portions disposed at opposite longitudinal ends thereof, wherein the first wall structure comprises first and second side edges substantially perpendicular to the first free edge, wherein a first one of the tapered portions extends toward the first side edge and is interposed between the first free edge and the first side edge.”

Applicants also respectfully direct the Examiner to Figures 4 and 8 of the application. In the non-limiting embodiment of Figures 4 and 8 in the present Application, a tapered portion 68 extends from the first free edge 23 toward a side edge 600. Further, the tapered portion 68 interconnects and is interposed between the free edge 23 and the side edge 600. For the Examiner's convenience, Figure 4 is reproduced below with additional reference numbers.



In the frame 12 and 13 of Ridgeway, however, any one of the side panels 15, 17, 20 and 22 has no tapered portion between the free edge, for example, 1004 and the side edges, for example, 1000 and 1002. See Figure 5 of Ridgeway.

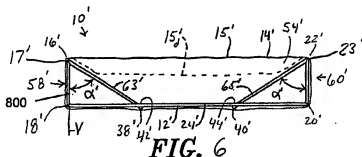
As such, Ridgeway fails to teach or suggest such features among other features of Claims 36 and 38. Therefore, Ridgeway does not teach or suggest all the features of Claims 36 and 38 and dependent Claims 39-41. There is no additional reference or non-

reference prior art to remedy the deficiencies of Ridgeway. Further, there is no explanation as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Therefore, no *prima facie* case of anticipation or obviousness has been established. Applicants respectfully request the withdrawal of the rejection to Claims 36 and 38 and dependent Claims 39-41.

Claim 45

In contrast with Ridgeway, Claim 45 recites, among other recitation, "wherein the third and fourth free edges are configured to be positioned in the first and second open sides in nesting engagement, respectively, wherein each of the first and second peripheral extending structures comprises two walls, wherein one of the walls inclined with respect to the other of the walls."

Applicants also respectfully direct the Examiner to Figures 6 and 8. In the non-limiting embodiment of Figures 6 and 8 in the present Application, a peripheral extending structure 58' includes two walls 800 and 63'. The wall 63' is inclined with respect to the wall 800. For the Examiner's convenience, Figure 6 is reproduced below with additional reference numbers.



However, no one of the side panels 12, 13, 14, 15, 20, 21, 22 and 23 of Ridgeway has an inclined wall. See Figure 5 of Ridgeway.

As such, Ridgeway fails to teach or suggest such features among other features of Claim 45. Therefore, Ridgeway does not teach or suggest all the features of Claim 45. There is no additional reference or non-reference prior art to remedy the deficiencies of Ridgeway. Further, there is no explanation as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.

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Therefore, no *prima facie* case of anticipation or obviousness has been established. Applicants respectfully request the withdrawal of the rejection to Claim 45.

Claim 74

In contrast with Ridgeway, Claim 74 recites, among other recitation, "a first retention sleeve surrounding the first frame member and comprising a first retention portion which extends between the first and second free edges," and "a second retention sleeve surrounding the second frame member and comprising a second retention portion which extends between the third and fourth free edges."

Applicants also respectfully direct the Examiner to Figures 4 and 6. In the non-limiting embodiment of Figures 4 and 6 in the present Application, retention sleeves 14 receive frame members 12 and 12', respectively. See Figures 4 and 6 reproduced above.

In Ridgeway, however, no sleeve is provided as a retention member. See Figures 2-5 of Ridgeway. As such, Ridgeway fails to teach or suggest such features among other features of Claim 74. Therefore, Ridgeway does not teach or suggest all the features of Claim 74 and its dependent Claims 75-86. There is no additional reference or non-reference prior art to remedy the deficiencies of Ridgeway. Further, there is no explanation as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Therefore, no *prima facie* case of anticipation or obviousness has been established. Applicants respectfully request the withdrawal of the rejection to Claim 74 and its dependent Claims 75-86.

Claims 33 Are Patentable over Smith

The Examiner maintained the rejection to Claims 33-35, 37, 43, 44 and 46 under 35 U.S.C. § 102(b or e) or 35 U.S.C. § 103(a) over U.S. Patent No. 6,311,843 to Smith. Applicants respectfully traverse the present rejection and submit that Smith is in fact not prior art under 35 U.S.C. §§ 102 (b or e) nor 103(a) with respect to pending Claims 33-35, 37, 43, 44 and 46. However, in order to expedite the prosecution, Applicants have amended Claim 33 as set forth above. Applicants expressly reserve the right to further prosecute the original versions of the claims through continuation practice.

As discussed above, Claim 33 recites, among other recitation, "wherein the first wall structure comprises two side edges generally perpendicular to the first free edge, wherein

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the second wall structure comprises two side edges generally perpendicular to the second free edge, wherein the third wall structure comprises two side edges generally perpendicular to the third free edge, wherein the first and second frames are sized such that a distance between the side edges of the third wall structure is substantially same with that between one of the side edges of the first wall structure and one of the side edges of the second wall structure when viewed in a direction perpendicular to the third wall structure in nesting engagement.”

In contrast, Smith discloses only the configuration in Figures 33-35 that a distance between side edges of a panel 642 or 644 is larger than a distance between side panels 622 and 624. As such, Smith fails to teach or suggest such features among other features of Claim 33. Therefore, Smith does not teach or suggest all the features of Claim 33, and its dependent Claims 34, 35, 37, 43, 44 and 46. There is no additional reference or non-reference prior art to remedy the deficiencies of Smith. Further, there is no explanation as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Therefore, no *prima facie* case of anticipation or obviousness has been established. Applicants respectfully request the withdrawal of the rejection to Claim 33 and its dependent Claims 34, 35, 37, 43, 44 and 46.

#### Smith Does Not Qualify as a Prior Art for Rejecting Claim 74

The Examiner maintained the rejection to Claims 74-86 under 35 U.S.C. § 102(b) or e) or 35 U.S.C. § 103(a) over Smith. Applicants respectfully traverse the present rejection and submit that Smith is in fact not prior art under 35 U.S.C. §§ 102 (b or e) nor 103(a) with respect to pending Claims 74-86.

Firstly, in paragraph 4 in page 2 of the Office Action, it is stated that the parent applications identified by applicants do not appear to support the embodiments that are the subject of the noted rejections. However, both parent applications, U.S. Patent Application No. 09/690,790, filed October 17, 2000, now Patent No. 6,675,973 B1 (the “parent nonprovisional application”) which claims priority to U.S. Provisional Patent Application No. 60/227,724, titled SUSPENSION PACKAGING ASSEMBLY, filed July 31, 2000 (the “parent provisional application”) disclose embodiments supporting Claims 74-86.

Claims 74-86, are supported by the present application, for example, Figures 1-8



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and related descriptions of pages 9-15 of the application originally filed. These figures and descriptions can be found in the parent applications, for example, Figures 1-8 and pages 9-15 of the parent nonprovisional application, and Figures 1-8 and pages 9-15 of the parent provisional application.

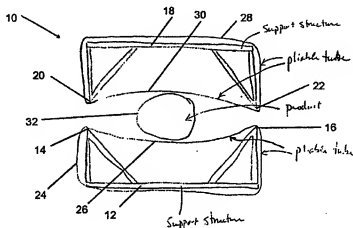
As such, Claims 74-86 are supported by the parent applications filed prior to the publication date of Smith. Therefore, Smith does not qualify as prior art under 35 U.S.C. § 102(b).

Secondly, in reply to the remaining statements in the Office Action regarding the copy of a letter attached to the signed declaration, Applicants replace the submitted copy of the letter from William H. Shreve of Knobbe Martens Olson & Bear LLP dated May 28, 1999 with a new copy of the letter including fewer redacted portions than the previously submitted copy, as well as a supplemental declaration from the inventors of the present Application.

In particular, Applicants have un-redacted nearly all of the text of the original letter to Stanley Schwartz. Further, Applicants would like to point out that the un-redacted portion of the letter now indicates that a copy of a patent is enclosed as well as figures illustrating the subject of the search. Applicants also wish to point out that pages 3-8 include minor unredacted portions to show that these pages are merely a copy of a patent and thus have no relevance to the present rejection.

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Further, Applicants respectfully submit that the drawing of Figure 2 of the unredacted letter accompanying the supplemental declaration show all of the elements recited in Claim 74. For the Examiner's convenience, the drawings are reproduced below with additional reference numbers.



In the non-limiting embodiment of the drawings reproduced above, a packaging assembly 10 is shown. The packaging assembly 10 has a first frame member 12 having first and second free edges 14 and 16, and a second frame member 18 having third and fourth free edges 20 and 22. A first retention sleeve 24 surrounds the first frame member 12 and includes a first retention portion 26 which extends between the first and second free edges 14 and 16. A second retention sleeve 28 surrounds the second frame member 18 and includes a second retention portion 30 which extends between the third and fourth free edges 20 and 22. The first and second frame members 12 and 18 are assembled such that an article 32 is located between the first retention portion 26 and the second retention portion 30.

Applicants also wish to point out that the supplemental declaration submitted herewith also includes an additional explanation of the embodiment of Figure 2 of the May 28, 1999 letter and the embodiment of Figure 8 of the present Application. As set forth in the Supplemental Declaration, the drawing of Figure 2 of the May 28 letter is shown in a state where one of the frame members is rotated 90 degrees (about the vertical axis) from the correct position during use. Further, the Declarants clarify that the prototype that they created before October 1, 1999 included all of the features of Figure 8 of the present Application. Applicants

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thus submit that Figure 2 of the May 28, 1999 letter sufficiently corroborates the Declarants' statements that they created a prototype including all of the features of Figure 8 of the present Application.

As such, Applicants submit that they reduced to practice an embodiment of Claim 74 prior to the effective date of the Smith reference and thus Smith does not qualify as a prior art under 35 U.S.C. § 102(e).

Because Smith does not qualify as a prior art under 35 U.S.C. § 102, it also cannot qualify as prior art under 35 U.S.C. § 103(a). Accordingly, Applicants submit that Claims 74-86 are currently in condition for allowance.

#### CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 23, 2008

By: /Michael Guilian/

Michael A. Guilian  
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	McDonald et al.
Appl. No.	:	10/726,256
Filed	:	December 2, 2003
For	:	SUSPENSION PACKAGING ASSEMBLY
Examiner	:	Jacob K. Ackun
Group Art Unit	:	3728

**SUPPLEMENTAL DECLARATION PURSUANT TO 37 C.F.R. § 1.131**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Supplemental to the Declaration executed April 25, 2008, this declaration is submitted to provide additional evidence of an invention date of embodiments claimed in the above-captioned patent application prior to October 1, 1999, the filing date of U.S. Patent No. 6,311,843 B1 to Smith et al. ("Smith").

We, John McDonald, Myles Comerford and Frank Comerford, declare as follows:

1. We are the named inventors of the above-captioned patent application and are familiar with the prosecution of the application.
2. Attached as Exhibit A is another copy of the letter from William H. Shreve at Knobbe Martens Olson & Bear LLP dated May 28, 1999 submitted with our previous declaration. However, this copy has been partially unredacted so as to allow for further review of additional paragraphs included in this letter. Additionally, we note that the remaining redactions in Exhibit A, including pages 3-8 are simply irrelevant to the issues being addressed in this declaration and our response to the outstanding Office Action.
3. At page 8 of Exhibit A, there is a drawing of an embodiment that corresponds to the embodiment of Figure 8 of the above-identified application (U.S. Patent Application Serial No. 10/726256). The drawing at page 8 of Exhibit A shows the two frame members, each having

Appl. No. : 10/726,256  
Filed : December 2, 2003

free edges and encircled by retention sleeves, respectively. In the drawing of page 8 of Exhibit A, the two frame members are shown in an exploded and face-to-face orientation. However, our concept was that one of the frame members would be rotated 90 degrees (about a vertical axis as viewed in the drawing of page 10 of Exhibit A). This rotated orientation is clearly illustrated in Figure 8 of the present Application but Exhibit A simply did not include such a drawing.

4. As noted in our previous declaration, we created a prototype of the embodiment of page 8 of Exhibit A, at least prior to October 1, 1999. That prototype included all of the features illustrated in Figure 8 of the present Application. We believe that the drawing of page 8 of Exhibit A corroborates our position.

3. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 12-19-08

By: John McDonald  
John McDonald

Dated: 12-19-08

By: Myles Comerford  
Myles Comerford

Dated: 12-19-08

By: Frank Comerford  
Frank Comerford

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# APPENDIX A

INTELLECTUAL PROPERTY LAW

**KNOBBE, MARTENS, OLSON & BEAR**

A LIMITED LIABILITY PARTNERSHIP INCLUDING  
PROFESSIONAL CORPORATION

**PATENT, TRADEMARK AND COPYRIGHT CAUSES**

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AUSY C. CHRISTENSEN  
SHELIA H. SVANOSUP

May 28, 1999

VIA FACSIMILE

Stanley Schwartz, Esq.  
Schwartz & Weinrieb  
1109 Crystal Plaza, Building 1  
2001 Jefferson Davis Highway  
Arlington, Virginia 22202

Re: Patentability Search for Membrane Packaging  
Our Reference No. FCMCCG.002A

Dear Stan:

Please conduct a patentability search for the invention described below. I would appreciate receiving the results of the search by the end of next week if possible.

The invention relates to an improved form of membrane packaging. By way of background information, I am enclosing a copy of a patent

**REDACTED**

An aspect of the present invention relates to an improved coupling between the frame structure and the pliable material. The pliable layer is formed with pockets into which a portion of the frame or substrate fit. I am enclosing a sketch of this feature (Figure 1) to aid you in understanding the invention.

Another aspect of the invention involves using a tubular piece of pliable material. In one mode, the material wraps around the frame or support structure (as seen in Figure 2) with the

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\* A PROFESSIONAL CORPORATION  
IN NEW YORK STATE, NY  
IN MISSOURI AT LAW, MO.  
U.S. PATENT AGENT

KNOBBE, MARTENS, CURTIS & BEAR

Stanley Schwartz, Esq.

May 28, 1999

Page -2-

product positioned between two support structures. In another mode, tube of pliable material holds the product to the support structure (Figure 3). A heat shrinkable material can be used as the tubular material in both these modes.

Please direct your search to both of these aspects of the membrane packaging. In addition, if you identify other relevant background art, please also include such with the search results.

I look forward to receiving the search results as soon as possible. In the meantime, if you have any questions or comments regarding the invention, please call me at 949-721-2895.

Very truly yours,

A handwritten signature in dark ink, appearing to read "Bill", written in a cursive style.

William H. Shreve

Enclosures

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United States Patent [19]

**REDACTED**

**U.S. Patent**

**REDACTED**

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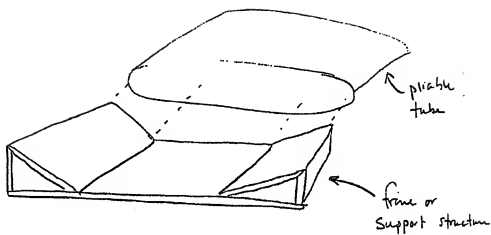
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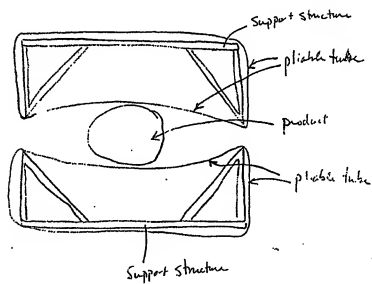
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*Figure 1*



(a) packaging components



(b) Assembly with product between two support structures

Figure 2



**REDACTED**

Figure 3

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	4515381
<b>Application Number:</b>	10726256
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	3528
<b>Title of Invention:</b>	Suspension packaging assembly
<b>First Named Inventor/Applicant Name:</b>	John McDonald
<b>Customer Number:</b>	20995
<b>Filer:</b>	Michael A. Guiliana/Brittany West
<b>Filer Authorized By:</b>	Michael A. Guiliana
<b>Attorney Docket Number:</b>	FCMCCG.002DV1
<b>Receipt Date:</b>	23-DEC-2008
<b>Filing Date:</b>	02-DEC-2003
<b>Time Stamp:</b>	18:44:57
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$245
RAM confirmation Number	4357
Deposit Account	111410
Authorized User	KNOBBE MARTENS OLSON AND BEAR
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: Charge any Additional Fees required under 37 C.F.R. Section 1.16 (National application filing, search, and examination fees) Charge any Additional Fees required under 37 C.F.R. Section 1.17 (Patent application and reexamination processing fees)	

**File Listing:**

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		FCMCCG002DV1_Amendment.pdf	837740 290a3d6dc01d814433072477b0d0b067a13a6559	yes	19
Multipart Description/PDF files in .zip description					
Document Description			Start	End	
Amendment/Req. Reconsideration-After Non-Final Reject			1	1	
Claims			2	8	
Applicant Arguments/Remarks Made in an Amendment			9	19	
Warnings:					
Information:					
2	Rule 130, 131 or 132 Affidavits	FCMCCG002DV1_Declaration.pdf	299476 78043ae15d72b01d5b79a022493081123e76a8d0	no	14
Warnings:					
Information:					
3	Fee Worksheet (PTO-06)	fee-info.pdf	29801 2f730017496be0976c229a099e010a164241e5263	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			1167017		
This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.					
New Applications Under 35 U.S.C. 111					
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.					
National Stage of an International Application under 35 U.S.C. 371					
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.					
New International Application Filed with the USPTO as a Receiving Office					
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.					

**Electronic Patent Application Fee Transmittal**

<b>Application Number:</b>	10726256			
<b>Filing Date:</b>	02-Dec-2003			
<b>Title of Invention:</b>	Suspension packaging assembly			
<b>First Named Inventor/Applicant Name:</b>	John McDonald			
<b>Filer:</b>	Michael A. Guiliiana			
<b>Attorney Docket Number:</b>	FCMCCG.002DV1			
Filed as Small Entity				
<b>Utility under 35 USC 111(a) Filing Fees</b>				
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>
<b>Basic Filing:</b>				
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
<b>Petition:</b>				
<b>Patent-Appeals-and-Interference:</b>				
<b>Post-Allowance-and-Post-Issuance:</b>				
<b>Extension-of-Time:</b>				
Extension - 2 months with \$0 paid	2252	1	245	245

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				245

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875				Application or Docket Number <b>10/726,256</b>		Filing Date <b>12/02/2003</b>		<input type="checkbox"/> To be Mailed		
<b>APPLICATION AS FILED – PART I</b>										
(Column 1)				(Column 2)		SMALL ENTITY <input checked="" type="checkbox"/>		OR OTHER THAN SMALL ENTITY		
FOR		NUMBER FILED		NUMBER EXTRA		RATE (\$)		FEE (\$)		
<input type="checkbox"/> BASIC FEE (37 CFR 1.16(a), (b), or (c))		N/A		N/A		N/A		N/A		
<input type="checkbox"/> SEARCH FEE (37 CFR 1.16(b), (f), or (m))		N/A		N/A		N/A		N/A		
<input type="checkbox"/> EXAMINATION FEE (37 CFR 1.16(a), (p), or (q))		N/A		N/A		N/A		N/A		
TOTAL CLAIMS (37 CFR 1.16(i))		minus 20 =		*		X \$ =		OR X \$ =		
INDEPENDENT CLAIMS (37 CFR 1.16(h))		minus 3 =		*		X \$ =		OR X \$ =		
<input type="checkbox"/> APPLICATION SIZE FEE (37 CFR 1.16(s))		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))										
* If the difference in column 1 is less than zero, enter "0" in column 2.										
<b>APPLICATION AS AMENDED – PART II</b>										
(Column 1)				(Column 2)		(Column 3)		SMALL ENTITY OR OTHER THAN SMALL ENTITY		
<b>AMENDMENT</b>	<b>12/23/2008</b>		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA			
	Total (or CFR 1.16(i))		* 24		Minus ** 41		= 0			
	Independent (37 CFR 1.16(j))		* 5		Minus *** 8		= 0			
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))									
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
	TOTAL ADD'L FEE		0							
<b>AMENDMENT</b>	(Column 1)		(Column 2)		(Column 3)		SMALL ENTITY OR OTHER THAN SMALL ENTITY			
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA		RATE (\$)		ADDITIONAL FEE (\$)	
	Total (or CFR 1.16(i))		*		Minus **		=			
	Independent (37 CFR 1.16(j))		*		Minus ***		=			
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))									
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
TOTAL ADD'L FEE		0								
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3. ** If the "Highest Number Previously Paid For" in THIS SPACE is less than 20, enter "20". *** If the "Highest Number Previously Paid For" in THIS SPACE is less than 3, enter "3". The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.										

Legal Instrument Examiner:  
/Doretta Brooks/

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Your self may depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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